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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,777	03/22/2004	Lee H. Angros	233.032	9934

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EXAMINER	
ALEXANDER, LYLE	

ART UNIT	PAPER NUMBER
1743	

MAIL DATE	DELIVERY MODE
06/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/805,777	ANGROS, LEE H.	
	Examiner	Art Unit	
	Lyle A. Alexander	1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 May 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *See Continuation Sheet* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *83-86,88,92,95-98,101,104,107-115,117,120-125,127-128,132 and 184-195* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ ~~Notice of References Cited (PTO-892)~~

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

Continuation of Disposition of Claims: Claims pending in the application are 83-86,88,92,95-98,101,104,107-115,117,120-125,127,128,132 and 184-195.

During the 5/30/07 Pre-Brief Conference, several new 35 USC 112 fist paragraph issues concerning new matter were discovered that were not previously rejected. Additionally, updating the search yielded new references that should be considered. The Office is making the following new grounds of rejections.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 83-86,88,92,95-98,101,104,107-115,117,120-125,127-128,132 and 184-195 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The instant claim language "absorbent material" is new matter not supported by the original disclosure. Additionally, the claim language "there is no gap there between" is also new matter not supported by the original disclosure.

Specification

The amendment filed 2/7/06 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the 2/7/06 amendments that add "absorbent material" to the specification is new matter and should be deleted.

Applicant is required to cancel the new matter in the reply to this Office Action.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 83-86,88,92,95-98,101,104,107-115,117,120-125,127-128,132 and 184-195 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 21 of copending Application No. 11/404,416. Although the conflicting claims are not identical, they are not patentably distinct from each other because both are directed to the application of siloxane, etc. to a surface creating a film having a thickness of less than 0.0001 inch.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 83-86,88,92,95-98,101,104,107-115,117,120-125,127-128,132 and 184-195 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yanus et al.

Yanus et al. teach in column 12 lines 17+ polysiloxanes are transparent materials and are employed in 10-75% solutions, where the balance of the solution has been read on the claimed "solvent". Examples IV, VI, VII etc. the formation of a 200 Angstrom siloxane layers which have been read on the claimed layer of "... less than 0.0001 inch". Column 6 lines 24+ teach the use of strong mineral acids. The claimed language "... applicator device is a pen or is pen-like" is sufficiently broad that it has been read on the means by which the 200-Angstrom layer was formed.

Yanus et al. are silent to the claimed "body, a reservoir within the body and integral to the body, and an applicator end..." to contain the polysiloxanes.

Applicant states in paragraph [0034] of the instant disclosure, applicator pens, such as the "PAP Pen" are well known in the art. Pen applicators are advantageous because they are inexpensive, light weight, small in size, can be used easily, do not require specialized training for the technician and do not require additional expensive complex equipment to control the application.

It would have been within the skill of the art to modify Yanus et al. and use a well-known type of applicator, such as a pen applicator, to gain the above advantages.

Claims 83-86,88,92,95-98,101,104,107-115,117,120-125,127-128,132 and 184-195 are rejected under 35 U.S.C. 103(a) as being unpatentable over Badesha et al. (USP 4,855,201).

Badesha et al. teach in examples IV and I a Bird Applicator applying a to silicon layer of a thicknesses between 0.4 and 2 microns respectively in the presence of other solvating materials. This has been read on the claimed solvent and silicon layer of less than 0.0001 inch.

Badesha et al. are silent to the claimed "body, a reservoir within the body and integral to the body, and an applicator end..." to contain the polysiloxanes.

Applicant states in paragraph [0034] of the instant disclosure, applicator pens, such as the "PAP Pen" are well known in the art. Pen applicators are advantageous because they are inexpensive, light weight, small in size, can be used easily, do not require specialized training for the technician and do not require additional expensive complex equipment to control the application.

It would have been within the skill of the art to modify Badesha et al. and use a well-known type of applicator, such as a pen applicator, to gain the above advantages.

Response to Arguments

Applicant's arguments filed 5/2/07 have been fully considered but they are not persuasive.

Applicant states in point "(1)", the cited prior art fails to teach the claimed no gap between the applicator and analytical plate. Upon further consideration, the Office believes the corresponding claim limitations to these remarks are new matter. Even if

there was support for such language, it is not clear how there can be no gap between the applicator end and the plate. For the fluid to be applied in the claimed thin film, the fluid would have to be between the applicator and the plate.

Applicant states in points "(2)" and "(5)" the cited prior art fails to teach the claimed "absorbent material". The above rejection states this is new matter because the original specification does not define this term. Even if Applicant were to change the language to a "swab", which is disclosed in paragraph [0033] of the original specification, the Office will maintain the steel applicator of the cited prior art will retain fluid by surface tension or capillary action (Applicant states in the last paragraph on page 2 of the 5/2/07 response the liquid is held to the Bird Application by capillary action) and will be read on a limitation directed to a "swab".

Applicant states in point "(3)" the cited prior art fails to teach the claimed reservoir containing the solvent in the body of the applicator. The Office maintains the language is broad enough to be read on the combination of the taught applicator and the reservoir of solvent.

Applicant states in point "(4)" the cited prior art fails to teach the applicator is made of plastic. These remarks are not commensurate in scope with the pending claims that are not directed to a plastic applicator. Furthermore, upon a cursurary review of the original specification, it does not appear a plastic application is ever taught. If limitations to a plastic applicator were submitted, they would be rejected under 35 USC 112 first paragraphs as new matter.

Applicant states in point "(6)" the Office has not properly considered the 10/18/06 Declarations. The weigh to give a declaration will depend upon the amount of factual evidence in the declaration contains to support the conclusion. MPEP section 2164.05 references *In re Buchner;* 929 F.2d 660,661, 18 USPQ2d 1331,1332 (Fed. Cir. 1991)("expert's opinion on the ultimate legal conclusion must be support by something more than conclusory statements). The Office maintains the 10/18/06 Declarations contained conclusory statement by Dr. Angros and has been given the appropriate weight.

Applicant states in point "(7)" the limitations referenced by the Office "construction of a material which is different from a material to construct the body" is no longer pending and the Office's reference to *In re Larson* appears to be irrelevant. The Office has rewritten the rejection to address the pending language. The Office maintains *Larson* has been properly applied to address the limitation directed to "a reservoir within and integral to the body".

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A. Alexander whose telephone number is 571-272-1254. The examiner can normally be reached on Monday, Wednesday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Lyle A Alexander
Primary Examiner
Art Unit 1743

